

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)	
)	
Dorriah L. Page Ph.D. et al.)	Examiner: Not assigned
)	
Serial No.: 09/831,207)	Group Art Unit: Not assigned
)	
Filed: May 4, 2001)	
)	
Title: INTEGRATED APPARATUS)	June 27, 2002
FOR REMOVING POLLUTANTS)	
FROM A FLUID STREAM IN A)	
LEAN-BURN ENVIRONMENT WITH)	
HEAT RECOVERY)	
_____)	

RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)

Assistant Commissioner
for Patents
Box PCT
Washington D.C. 20231
Attn: PCT Legal Office

Sir:

Pursuant to 37 C.F.R. § 1.47(a), Applicants hereby renew their petition to file the above-identified application without joining of two of three joint inventors.

Applicants acknowledge receipt of the Decision on Petition dated April 30, 2002, a copy of which is enclosed, as well as the comments of the Petitions Attorney during a subsequent teleconference. In the Decision, the Examiner acknowledges that the previously-submitted Petition satisfies the requirements of 37 C.F.R. § 1.47(a)(1),

(3) and (4). However, the Examiner alleged that the Petition did not meet the requirements of 37 C.F.R. § 1.47(a)(2). Specifically, the Examiner referred to MPEP § 409.03(d), which states: "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." The Examiner stated that "there is no evidence in the present petition or accompanying papers that applicant has made a bona fide attempt to present Dr. Dorrish [sic] L. PAGE and Robert J. MACDONALD with a copy of the application papers, including the specification, claims and drawings as required." Therefore, the Examiner dismissed Applicants' Petition.

After teleconference with Mr. Derek A. Putonen, Petitions Attorney, on May 30, 2002, Applicants have prepared a Renewed Petition addressing the Examiner's concerns. In support of this Renewed Petition, Applicants submit herewith the following:

- (1) A copy of the previously received Decision on Petition;
- (2) The declaration of Oral Caglar, an attorney with Sheppard, Mullin, Richter & Hampton LLP, and attorney of record in the above-referenced application; and
- (3) Exhibit A to this Renewed Petition, a copy of a letter dated May 30, 2002 sent via expedited mail to Irwin Chasalow, Esquire, attorney for Dr. Page, one of the two non-signing inventors in the application; and

- (4) Exhibit B to this Renewed Petition, a copy of a letter dated June 3, 2002 sent via expedited mail to Mr. MacDonald, the other non-signing inventor in the application;

Applicants believe that the documents now provided, in addition to those provided in the original Petition, meet the requirements of 37 C.F.R. § 1.47(a)(2). Specifically, in item (2), Mr. Caglar states that he sent copies of the published International Application in the above-referenced U.S. national stage application, along with copies of the declaration for signature, to the last known contact addresses of the non-signing inventors. Copies of the cover letters sent with these documents are included as Exhibits A and B to this Renewed Petition. Applicants note that the address to which the letter to Mr. MacDonald was sent is not identical to that indicated in the previous Petition and Declaration of Bradley Edgar. The previously-indicated address was incorrect due to a typographical error. The correct last known address of Robert J. MacDonald is: 6200 Vista Del Mar, Suite 207, Playa Del Rey, California 90923.

In Item (2), Mr. Caglar also states that the International Application was not amended prior to entering the national stage, and therefore, it is a copy of the specification of the application as filed in the above-referenced U.S. application. Finally, Mr. Caglar states that as of June 27, 2002, he has not received a signed declaration from either of the non-signing inventors, or any indication that either non-signing inventor intends to do so. In fact, he has received specific refusal to do so from Mr. Chasalow.

Applicants submit that the submission of the International Application along with the declaration to the last known addresses of each of the non-signing inventors represents a *bona fide* effort to present a copy of the specification in the

present application. Therefore, Applicant believes that all requirements under 37 C.F.R. § 1.47(a)(2) are met by this Renewed Petition. The Examiner is invited to contact the prosecuting attorney at (213) 617-5516 to advance granting of this Renewed Petition.

In view of the items submitted herewith, granting of this Renewed Petition is respectfully requested.

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By: _____

Oral Caglar

Registration No. 44,577

333 South Hope Street, 48th Floor
Los Angeles, California 90071
(213) 620-1780

Enclosures



30 Apr 2002

Oral Cagler
Sheppard, Mullin, Richter & Hampton, LLP
333 South Hope Street, 48th Floor
Los Angeles, California 90071

In re Application of	:	
PAGE, et al.	:	DECISION ON PETITIONS
Application No.: 09/831,207	:	
PUT No.: PCT/US99/26050	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 04 November 1999	:	
Priority Date: 06 November 1998	:	AND 37 CFR 1.47(a)
Attorney Docket No.: WDF-69436	:	
For: INTEGRATED APPARATUS FOR	:	
REMOVING POLLUTANTS FROM A	:	
FLUID STREAM IN A LEAN-BURN	:	
ENVIRONMENT WITH HEAT	:	
RECOVERY	:	

BACKGROUND

On 04 November 1999, applicants filed the international application, which claimed a priority date of 06 November 1998. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 06 May 2001.

On 04 May 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by a copy of the International Preliminary Examination Report and a copy of the International Search Report. Applicant did not provide either payment of the full U.S. basic national fee nor an oath or declaration of the inventors.

On 25 May 2001, applicants were mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) notifying applicants that the above-identified application was abandoned as to the United States for failure to provide payment of the full U.S. basic national fee by thirty months from the claimed priority date.

On 06 February 2002, applicant responded with the present petitions. A petition for revival under 37 CFR 1.137(b) and a petition under 37 CFR 1.47(a). Accompanying the petition under 37 CFR 1.47(a) was a declaration for patent application executed by joint-inventor Dr. Bradley L. EDGAR. The declaration for patent application was not executed by joint-inventors Dr. Dorrish L. PAGE and Robert J. MACDONALD, the subjects of the present petition under 37 CFR 1.47(a).

DISCUSSION

A. Petition to Revive Under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

With regard to Item (1), the proper response was payment of the full U.S. basic national fee. Applicants have provide said payment with the present petitions.

As to Item (2), applicants have paid the \$1280.00 petition fee.

With regard to Item (3), applicants' statement that, "the entire delay in submitting item (1) above, (the basic national fee) from the due date for submitting the item until the filing of this petition, was unintentional" satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

Applicant having complied with the above requirements, the petition under 37 CFR 1.137(b) to revive the application is **GRANTED**.

B. Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to Items (1) and (3), applicant has provided a check in the amount of \$130.00 as payment of the required petition fee. In addition, the petition states the last known addresses of the non-signing inventors.

Regarding Item (4), accompanying the petition is a declaration signed by the remaining inventor on his behalf, and on behalf of the non-signing inventors. Accordingly, Items (1), (3) and (4) have been satisfied.

As to Item (2), the Manual of Patent Examination Procedure (MPEP), Section 409.03(d)

Proof of Unavailability or Refusal states that, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." The declarations which accompany the petition seem to indicate that the non-signing inventors were merely provided with a copy of the declaration. There is no indication in the present petition or accompanying papers that applicant has made a bona fide attempt to present Dr. Dorrish L. PAGE and Robert J. MACDONALD with a copy of the application papers, including the specification, claims and drawings as required.

Accordingly, since applicant has failed to show that Dr. Dorrish L. PAGE and Robert J. MACDONALD were provided with a complete set of the application papers and refused to sign the application papers it is not appropriate to accept the declaration at this time.

CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.137(b) is **GRANTED**.

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED**.

As authorized, \$130.00 will be deducted from Deposit Account No. 19-1853 as payment of the surcharge for providing an oath or declaration of the inventors later than thirty months from the earliest claimed priority date.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. A proper reply under the renewed petition would be either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard Smith
Legal Examiner
PCT Legal Office



Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

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LA:LCO\DEC\WDF\70428678.1

1 of the cover letter I sent to Mr. MacDonald with the published
2 International Application and the Declaration is attached as
3 Exhibit B.

4 4. Because the International Application was not
5 amended prior to entry into the national stage in the U.S., the
6 International Application includes the specification of the
7 Application.

8 5. As of June 27, 2002, I have not received a signed
9 declaration from either Mr. MacDonald or Dr. Page. It has been my
10 understanding that both Mr. MacDonald and Dr. Page previously have
11 refused to sign the Declaration. I have received no indication
12 from either Mr. MacDonald or Dr. Page that they now are willing to
13 do so. In fact, I have received a letter from Mr. Chasalow
14 indicating that he would not recommend that Dr. Page sign and
15 return the Declaration.

16 I declare under penalty of perjury under the laws of the
17 United States and the State of California that the matters set
18 forth above are true and correct and that this Declaration is
19 executed on June 27, 2002 at Los Angeles, California.

20 

21 Oral Caglar

22 Reg. No. 44,577
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28

SHEPPARD MULLIN
SHEPPARD MULLIN RICHTER & HAMPTON LLP

ATTORNEYS AT LAW
FORTY-EIGHTH FLOOR
333 SOUTH HOPE STREET
LOS ANGELES, CALIFORNIA 90071-1448
TELEPHONE 213-620-1780
FACSIMILE 213-620-1398
WWW.SHEPPARDMULLIN.COM

Oral Caglar
(213) 617-5516
ocaglar@smrh.com

Our File Number
WDF-69436

May 30, 2002

VIA FEDERAL EXPRESS

Irwin Chasalow, Esquire
1900 Avenue of the Stars, Suite 2300
Los Angeles, California 90067-4504

Re: U.S. Patent Application based on
PCT Patent Application No. US 99/26050
Serial No.: 09/831,207
Filed: May 4, 2001
Title: INTEGRATED APPARATUS AND METHOD FOR
REMOVING POLLUTANTS FROM A FLUID STREAM IN A
LEAN-BURN ENVIRONMENT WITH HEAT RECOVERY
Filed: May 4, 2001
Inventors: Dorriah L. Page, Ph.D.
Bradley L. Edgar, Ph.D.
Robert J. MacDonald

Dear Mr. Chasalow:

Enclosed is a copy of the published International Application from which the above-referenced U.S. application claims priority, along with an inventor's declaration. The published Application is identical in content to that forwarded to Robert MacDonald at Ceryx prior to its filing. Please forward the Application to Dr. Page for her file.

SHEPPARD MULLIN

SHEPPARD MULLIN RICHTER & HAMPTON LLP

ATTORNEYS AT LAW

Irwin Chasalow, Esquire

May 30, 2002

Page 2

The inventor's declaration is identical to that which we previously provided to her for signature and return. You previously had indicated that you were unaware of any obligation for Dr. Page to sign and return the declaration, and therefore you could not recommend to her that she do so. I have no documents relating to these obligations (such as, for example, an employment agreement). If, since our last discussion, you have located such documentation to your satisfaction, please have Dr. Page sign and return to us the declaration.

If you have any questions, please let me know.

Sincerely,



Oral Caglar

for SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

Enclosure

cc: James R. Brueggemann, Esquire

LA:LCOLET0WDF70428726.1

SHEPPARD MULLIN

SHEPPARD MULLIN RICHTER & HAMPTON LLP

ATTORNEYS AT LAW

Irwin Chasalow, Esquire

May 30, 2002

Page 3

bcc: Norman Sims, Esquire

From: Oral Caglar, Esquire (213)620-1780
SHEPPARD MULLIN
333 SOUTH HOPE STREET, 48TH FLOOR
LOS ANGELES, CA, 90071

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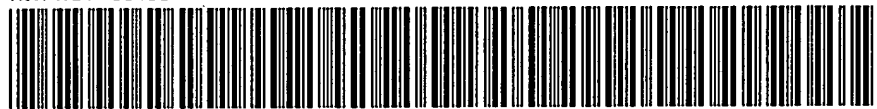
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To: Irwin Chasalow, Esquire (310)201-0777

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Suite 2300
Los Angeles, CA, 90067

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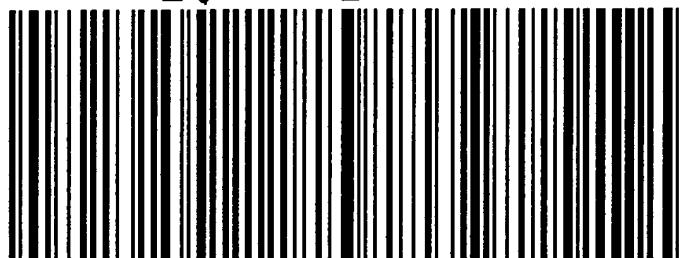
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SHEPPARD MULLIN RICHTER & HAMPTON LLP

ATTORNEYS AT LAW

FORTY-EIGHTH FLOOR
333 SOUTH HOPE STREET
LOS ANGELES, CALIFORNIA 90071-1448
TELEPHONE 213-620-1780
FACSIMILE 213-620-1398
WWW.SHEPPARDMULLIN.COM

Oral Caglar
ocaglar@sheppardmullin.com
(213) 617-5516

WDF-69436

June 3, 2002

VIA FEDERAL EXPRESS

Robert J. MacDonald, P.E.
6200 Vista Del Mar, Suite 207
Playa Del Rey, California 90923

Re: U.S. Patent Application based on
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Serial No.: 09/831,207
Filed: May 4, 2001
Title: INTEGRATED APPARATUS AND METHOD FOR
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Filed: May 4, 2001
Inventors: Dorriah L. Page, Ph.D.
Bradley L. Edgar, Ph.D.
Robert J. MacDonald

Dear Mr. MacDonald:

Enclosed for your file is a copy of the published International Application from which the above-referenced U.S. application claims priority, along with an inventor's declaration. The published Application is identical in content to that forwarded to you prior to its filing. The inventor's declaration is identical to that previously provided to you for signature and return. It is our understanding that you were unwilling to send us the signed declaration. If you now are willing to do so, please sign and return the declaration to me in the envelope provided at your earliest convenience.

SHEPPARD MULLIN

SHEPPARD MULLIN RICHTER & HAMPTON LLP

ATTORNEYS AT LAW

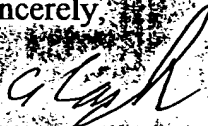
Robert J. MacDonald, P.E.

June 3, 2002

Page 2

If you have any questions, please let me know.

Sincerely,



Oral Caglar

for SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

LA-LCOLETWDF70429558.1

From: ORAL CAGLAR, ESQUIRE (213)620-1780
SHEPPARD MULLIN
333 SOUTH HOPE STREET, 48TH FLOOR
LOS ANGELES, CA, 90071

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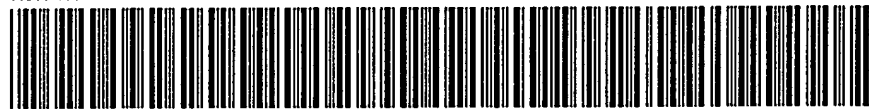
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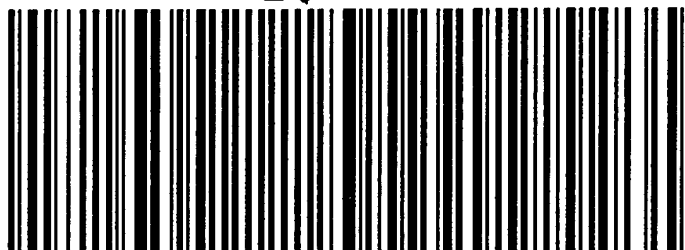
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